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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,766	09/18/2001	Anthony J. Mancuso	ELRP:101_US_	8533

24041 7590 01/27/2004
SIMPSON & SIMPSON, PLLC
5555 MAIN STREET
WILLIAMSVILLE, NY 14221-5406

EXAMINER

JILLIONS, JOHN M

ART UNIT	PAPER NUMBER
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3654

DATE MAILED: 01/27/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/954,766
Filing Date: September 18, 2001
Appellant(s): MANCUSO ET AL.

MAILED

JAN 27 2004

Sumita Chowdhury-Ghosh, Ph.D.
For Appellant

GROUP 3600

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 12, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-12 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

5,330,119	Rodriguez et al	7/1994
4,589,605	Orii	5/1986

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 6 and 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Rodriguez et al. Rodriguez et al discloses a free-standing coil reel hold-down device 266 (see Fig. 9) comprising a base plate 268 secured to floor 42 (col. 10, lines 6-7), a pivotal snubber arm 270 mounted to the base plate (col. 10, lines 9-11), the snubber arm 270 having two sections disposed at an obtuse angle with respect to one another (note the shape of the arm in Fig. 9 having two sections at an obtuse angle relative to each other, hence a "bell-crank), and a stand-alone means 274 for effecting a pivoting movement of the snubber arm relative to the base plate, col. 10, lines 11-14. With respect to claim 2 the first section of the snubber arm (to which the cylinder piston rod is connected) is disposed proximate the base plate. The snubber arm 270 includes a snubber device 272 mounted to the upper second section of the snubber arm 270, re claim 3. The means for effecting pivoting movement of the snubber arm comprises a cylinder 274, regarding claim 6. With respect to claim 10, one of the sections (the upper section as seen in Fig. 9) of the snubber arm 270 of Rodriguez et al is approximately three times the length of the other section. This one section can be called the "first" section since it is not specified in the claim which section is the first or second.

Claims 4-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez et al in view of Orii. The substitution of a roller, or equivalently a wheel in lieu of the sliding snubber member of Rodriguez et al would have been an obvious substitution especially in view of the teaching of Orii that a snubber member could be in the form of a roller or wheel-like member, note roller 23, and col. 2, lines 46-52 of Orii.

Claims 7-9, 11-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez et al. Regarding claims 7-8 whether the cylinder 274 of Rodriguez et al is pneumatically or hydraulically controlled would have been an obvious design consideration to one of ordinary skill in the art depending on the amount of pressure needed to force the snubber into engagement with the coil of material, i.e. a pneumatically operated cylinder would have been adequate for thin material, and a hydraulically operated cylinder would have been useful for thicker material as one of ordinary skill in the art at the time of the invention would have readily recognized. With respect to claims 9, 11-12 the particular obtuse angle between the two sections of the snubber arm of Rodriguez et al and the amount of pivoting movement of the arm would have been obvious design considerations to one of ordinary skill in the art inasmuch as these specific angles would have depended on the amount of and position of pivoting movement desired for a particular use. The amount and position of pivoting movement would have depended, e.g. on the location of the snubber relative to the location of the roll of material being snubbed, the stroke of the piston moving the snubber arm and how far away from the coil the snubber is located. Such considerations are seen to have been well within the purview of one of ordinary skill in the art and of no patentable significance.

(11) Response to Argument

The Anticipation Rejection

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Appellant argues that Rodriguez et al is not anticipatory of claim 1 because Rodriguez et al does not disclose that the snubber arm includes a first and a second section, does not disclose a first and second section disposed at an obtuse angle with respect to one another, does not disclose a pivoting movement of the snubber arm relative to the base plate and does not disclose a stand-alone means for effecting a pivoting movement of the snubber arm, see pages 4-7 of the Brief. In addition appellant refers to specific structure in Rodriguez et al that would purportedly support these arguments, i.e. that the arm of Rodriguez et al features a “one-piece bellcrank arm 270...that makes it impossible to have an obtuse angle in the arm”, page 4, last paragraph; that the bellcrank arm of Rodriguez et al is pivotally mounted at a point intermediate its ends and thus the pivot point for the arm is “far above the base” and therefore less stable, see the paragraph bridging pages 5-6 of the Brief; that the snubber mechanism 266 of Rodriguez et al is “mounted adjacent the arbor 26 containing the coil 10” and thus is not “free-standing” and would not include a “stand-alone” means for effecting a pivoting movement of the snubber arm, see the last paragraph on page 6 of the Brief; that the apparatus of Rodriguez et al “was designed to handle multiple coils” and requires at least two holding means and that these means “cannot be used as a separate, stand-alone coil reel hold-down device that can be retrofitted to existing coil reel feeding apparatus”, last two lines on page 6; and that appellant’s device can hold down coils of varying sizes and that the coil can be held down “from the top” because his arm includes two sections, see the paragraph in the middle of page 7 of the Brief.

However, a viewing of Fig. 9 of Rodriguez et al alone is adequate to support anticipation of claim 1 as well as claims 2-3, 6 and 10 as pointed out in the rejection above—a response follows:

With respect to the statement that the snubber arm of Rodriguez et al (hereafter Rodriguez) does not include first and second sections because it is a one-piece construction, it is submitted that a member constructed of one piece could have many different "sections". A structural member need not be composed of different pieces connected together to constitute different sections as implied by appellant. As can clearly be seen in Fig. 9 of Rodriguez the "bell-crank" arm is formed of two sections at an obtuse angle relative to each other and meets the terms of the claim.

Furthermore the snubber arm of Rodriguez is pivotably mounted to the base plate. Merely because its pivot is spaced above the bottom of the base plate does not mean it is not mounted on the base plate. The flanges holding the pivot mounting are part and parcel of the base plate, the same as the flange members holding the pivot on appellants' base plate bottom portion, see Fig. 7 of the present invention for example.

Also, while Rodriguez may use a lever system different from appellants'—i.e. one where the lever is pivotably mounted between its ends, rather than at one end thereof as in appellants' device, such difference is nowhere included in the claimed subject matter.

As far as the statement that the snubber of Rodriguez is mounted adjacent the arbor 26 and is thus not "free-standing", such is simply not accurate. The snubber of Rodriguez is mounted that same as in appellants' device—to the floor adjacent the arbor holding the roll of material, but separate therefrom. Thus the device of Rodriguez et al is as "free-standing" as appellants' device.

Further, the use of the term “stand-alone” to describe the means for effecting a pivoting movement of the snubber arm does not describe anything that is not included in the Rodriguez device. This “means” is merely the piston/cylinder of both appellants’ and Rodriguez’s snubber system.

Appellants’ further statement that the device of Rodriguez was designed to handle multiple coils, requires at least two holding means, etc. is immaterial whether or not this statement is true. In Rodriguez the snubber 266 is only used with one coil 10’, see Fig. 1. Merely because the machine of Rodriguez uses more than one coil because it is an automated uncoiling apparatus, i.e. one coil takes the place of another when the first is completely unwound, does not render the device of Rodriguez different from what appellants’ are claiming.

With respect to claims 2, 3, 6 and 10 appellants allege that Rodriguez does not teach these features. However, Fig. 9 of Rodriguez shows all of these features as pointed out in the rejection.

The Obviousness Rejections

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As to the rejection of claims 4-5 and the modification of Rodriguez by Orie, appellants state that Orie cannot cure the lack of teachings in Rodriguez, see the paragraph bridging pages 9-10 of the Brief. Further, subparagraph ii) on page 10 of the Brief, it is alleged that Orie is directed to actively uncoiling which teaches away from the coil reel "holddown" device of appellants invention. In column 2, lines 50-52 of Orie it is stated that "cylinder 24" causes the roller 23 to hold down the coiled material 7 keeping it from being unwound" (emphasis added). Thus Orie is directly related to the subject matter of appellants' invention and one of ordinary skill in the art would look to other related art mechanisms such as Orie when considering the claims of appellants' invention. Since Orie teaches the use of a roller to hold down material on a roll then the substitution of a roller for the sliding snubber in Rodriguez would have been clearly obvious in view thereof.

In subparagraph iii), page 10 of the Brief, appellants argue that the previously filed and considered affidavit alleging commercial success proves that the invention is not obvious. However, even though commercial success may be indicia of non-obviousness, patentability cannot be predicated on that indicia alone. The reasons for obviousness of appellants' claimed invention has been set forth previously and the affidavit does not overcome the rejection.

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Finally, appellants argue with respect to claims 9, 11-12 (claims 7-8 are not directed to the angle or amount of pivoting movement of the snubber arm) that the examiner has "failed to appreciate the significance of the particular angle between the sections of the arm and the particular amount of pivoting movement", page 12 of the Brief. As pointed out in the rejections above these particular limitations are not seen to be of patentable significance to one of ordinary skill in the art. Although Rodriguez specifically discloses an obtuse angled snubber arm that has an angle somewhat greater than the claimed angle or angular range, one of ordinary skill in the art would have readily recognized that the angle between the sections of the bell-crank arm of Rodriguez as well as the amount of movement would have been design considerations for the reasons presented previously. It should be asked however whether a ten or twenty degree difference in the angle between the sections of the snubber arm of Rodriguez or a slightly less amount of pivoting movement of the snubber arm as seen in Fig. 9 of Rodriguez would render patentable subject matter that is otherwise anticipated by a prior art device, especially if there are adequate reasons for making the modifications?

In response to appellants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teachings of Orii are clearly related to similar subject matter as that of Rodriguez and appellants' invention, and concerning the rejections of claims 7-9, 11-12 knowledge generally available to one of ordinary skill in the art provides motivation to make the modifications as pointed out previously.

In response to appellants' argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the snubber arm is pivotably mounted at one end thereof, that the coil is held down from the top, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In conclusion, the claimed subject matter is either anticipated by or fairly obvious over the cited prior art. Affirmation is requested.

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Respectfully submitted,

John M. Jillions
Primary Examiner
Art Unit 3654

jmj
January 25, 2004

Conferees

Kathy Matecki



Bill Rivera



SIMPSON & SIMPSON, PLLC
5555 MAIN STREET
WILLIAMSVILLE, NY 14221-5406